

SUPPORT FOR THE AMENDMENTS

The present amendment amends claims 43, 45-50, 52-75 and 79.

Claims 43, 45-50, 52-75 and 79 have been amended to place these claims in a better condition for allowance. Support for these amendments is provided by the originally filed claims and specification. It is believed that these amendments have not resulted in the introduction of new matter.

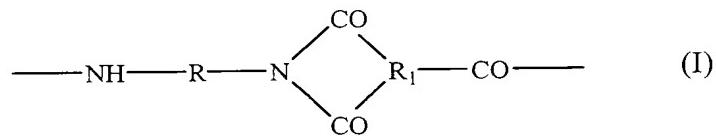
REMARKS

Claims 43, 45-50, 52-75, 79 and 81 are currently pending in the present application. Claims 43, 45-50, 52-75 and 79 have been amended by the present amendment.

Applicants wish to extend their appreciation to Primary Examiner Venkat for withdrawing the rejections under 35 U.S.C. §§ 102(b) and/or 103(a) as being anticipated and/or obvious over Colin (U.S. Patent 6,491,931).

The rejection of claims 43, 45-50, 52-75, 79 and 81 under 35 U.S.C. § 102(b) as being anticipated over Piot (U.S. 2002/0098217) is respectfully traversed.

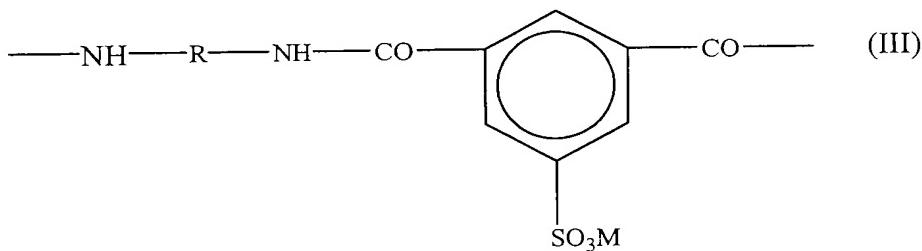
Amended claim 43 recites a mascara composition comprising *rigid, substantially rectilinear* polymeric fibers in a physiologically acceptable medium, wherein the polymer is selected from the group consisting of non-aromatic polyamides, aromatic polyimide-amides comprising a repeating unit of formula (I):



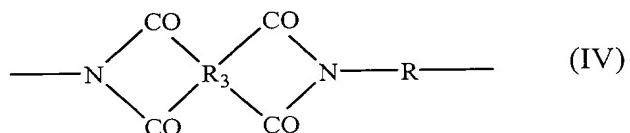
optionally, also, a repeating unit of formula (II):



optionally, also, a repeating unit of formula (III):



optionally, also, a repeating unit of formula (IV):



in which R represents a divalent aromatic group, R₂ represents a divalent aromatic group, R₃ represents a tetravalent aromatic group, R₁ represents a trivalent aromatic group and M represents an alkali metal or alkaline-earth metal, and mixtures thereof, and wherein at least 50%, in numerical terms, of the fibers are such that the angle formed between the tangent to the central longitudinal axis of the fiber at one of the ends of the fiber and the straight line connecting said end to the point on the central longitudinal axis of the fiber corresponding to half the length of the fiber, is less than or equal to 15°, and the angle formed between the tangent to the central longitudinal axis of the fiber at a point halfway along the fiber and the straight line connecting one of the ends to the point on the central longitudinal axis of the fiber corresponding to half the length of the fiber, is less than or equal to 15°, for the same length of fiber ranging from 0.8 mm to 5 mm.

Unlike the claimed invention, Piot describes polyamide fibers marketed by P. Bonte under the trade name “POLYAMIDE 0.9 Dtex 3 mm” (See e.g., [0032], Example 1 at [0181], Example 2 at [0183]). Colin likewise describes polyamide fibers marketed by P. Bonte under the trade name “POLYAMIDE 0.9 Dtex 3 mm” (See e.g., column 2, lines 54-57, and Example 1 at column 9, lines 30-31). Therefore, the polyamide fibers of Piot are *identical* to the polyamide fibers of Colin.

As shown by the comparative experimental data presented in the § 1.132 Declarations previously submitted on September 29, 2008 and October 22, 2008, the *flexible, curled* polyamide fibers of Colin are *fundamentally different* from the claimed *rigid, substantially rectilinear* polymeric fibers. Since the polyamide fibers of Piot are *identical* to the polyamide fibers of Colin, Piot necessarily fails to disclose or suggest the claimed rigid, substantially rectilinear polymeric fibers in accordance with mascara composition of the present invention for the same reasons that Colin fails to anticipate or render obvious to a skilled artisan the claimed rigid, substantially rectilinear polymeric fibers in accordance with mascara composition of the present invention, as acknowledged in the Notice of Allowance mailed December 16, 2008.

As acknowledged in the Official Action, Piot fails to disclose a mascara composition comprising rigid, substantially rectilinear polymeric fibers, as presently claimed.

However, the Office alleges that since the polymeric fibers of Piot are polyamide fibers, the polymeric fibers of Piot are inherently or intrinsically rigid, substantially rectilinear polymeric fibers, as presently claimed.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). When a claim limitation is not explicitly set forth in a reference, evidence must make clear that the missing descriptive matter is necessarily present in the reference and that it would be so recognized by skilled artisans. *In re Omeprazole Patent Litigation*, 82 USPQ2d 1643 (Fed. Cir. 2007). The fact that a certain result or characteristic may occur or be present in the reference is not sufficient to establish inherency of that result or characteristic. *In re Rijckaert*, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993). It is not sufficient if a material element or limitation is merely probably or possibly present in the reference. *Trintec Indus., Inc. v. Top-U.S.A. Corp.*, 63 USPQ 1597 (Fed. Cir. 2002) and *In re Robertson*, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999). To anticipate, the asserted inherent element must necessarily be present in the reference. *SmithKline Beecham Corp. v. Apotex Corp.*, 74 USPQ2d 1398 (Fed. Cir. 2005) and *In re Oelrich*, 212 USPQ 323, 326 (CCPA 1981).

The mere possibility that the polymeric fibers of Piot may be inherently or intrinsically rigid, substantially rectilinear polymeric fibers, as opposed to flexible, curled polymeric fibers, is an insufficient ground for arriving at a supportable conclusion of inherency. No evidence has been proffered by the Office establishing that the polymeric fibers of Piot are actually rigid, substantially rectilinear polymeric fibers, as opposed to flexible, curled polymeric fibers. The conclusion on page 3 of the Official Action that the polymeric fibers of Piot are inherently or intrinsically rigid,

substantially rectilinear polymeric fibers constitutes “official notice” that is not only unsupported by documentary evidence, but also in direct contradiction to the evidence already of record.

As previously discussed, the mascara composition of the present invention comprises *rigid, substantially rectilinear* polymeric fibers, which are composed of a polymer selected from the group consisting of non-aromatic polyamides, aromatic polyimide-amides, and mixtures thereof, as presently claimed.

Unlike the claimed invention, Piot describes polyamide fibers marketed by P. Bonte under the trade name “POLYAMIDE 0.9 Dtex 3 mm” (See e.g., [0032], Example 1 at [0181], Example 2 at [0183]). Colin likewise describes polyamide fibers marketed by P. Bonte under the trade name “POLYAMIDE 0.9 Dtex 3 mm” (See e.g., column 2, lines 54-57, and Example 1 at column 9, lines 30-31). Therefore, the polyamide fibers of Piot are *identical* to the polyamide fibers of Colin.

As evidenced by the comparative experimental data presented in the previously submitted Declarations under 37 C.F.R. § 1.132, copies of which are enclosed herewith for the Examiner’s convenience, the claimed *rigid, substantially rectilinear* polymeric fibers are *fundamentally different* from the *flexible, curled* polymeric fibers of Colin. Since the polyamide fibers of Piot are *identical* to the polyamide fibers of Colin, the claimed *rigid, substantially rectilinear* polymeric fibers are likewise *fundamentally different* from the *flexible, curled* polymeric fibers of Piot.

In the past, only conventional flexible, curled fibers have been used in traditional mascara compositions. Such flexible, curled fibers do not satisfy the rigidity and angle limitations recited in claim 43 (See e.g., present specification at page 3, lines 13-30 and page 6, lines 13-31 for a further explanation of the claimed rigidity and angle requirements). The present invention represents the first time that rigid, substantially rectilinear fibers have been used in a mascara composition. Thus, when Colin and Piot refer to “fibers,” these references are referring to conventional flexible, curled fibers which do not satisfy the requisite rigidity and angle limitations recited in claim 43.

Therefore, Colin and Piot merely describe incorporating conventional flexible, curled fibers into traditional cosmetic compositions. As a result, Colin and Piot fail to disclose or reasonably suggest to a skilled artisan incorporating the claimed rigid, substantially rectilinear polymeric fibers composed of the recited polymeric material into a mascara composition in accordance with the present invention. Colin and Piot also fail to recognize the remarkable benefits (e.g., improved eyelash lengthening properties) associated with the inclusion of such fibers in a mascara composition.

As shown by the comparative experimental data presented in the enclosed § 1.132 Declaration filed on September 29, 2008, the polyamide fibers of Colin and Piot, which are marketed by P. Bonte under the trade name “POLYAMIDE 0.9 Dtex 3 mm,” are *flexible, curled* polymeric fibers, rather than *rigid, substantially rectilinear* polymeric fibers, as presently claimed.

More specifically, Tab A of the § 1.132 Declaration includes photographs of (a) polyamide fibers (polyamide 6-6, 0.9 DTex, 3 mm), commercially available from P. Bonte; and (b) polyimide-amide fibers (Kermel Tech, 2 mm) commercially available from Rhodia. Both types of fibers were added to identical cosmetic base compositions.

As discussed in paragraph 2 of the § 1.132 Declaration and shown in the photograph illustrated in Tab A, the polyamide fibers from P. Bonte formed curved, non-linear structures, as opposed to the polyimide-amide fibers, which formed substantially linear structures. These photographs demonstrate that the polyamide fibers of Colin and Piot are flexible and curved, not rigid and substantially rectilinear as presently claimed, whereas the polyimide-amide fibers are rigid and substantially rectilinear.

The § 1.132 Declaration also compares a mascara composition of Example 1 comprising rigid, substantially rectilinear polyimide-amide fibers in accordance with an exemplary aspect of the present application to a traditional mascara composition of a Comparative Example that is substantially identical to Example 1 with the exception of alternatively containing conventional

Nylon polyamide fibers. As discussed in paragraph 4 of the § 1.132 Declaration, the angle formed between the tangent to the central longitudinal axis of the fiber at one of the ends of the fiber and the straight line connecting said end to the point on the central longitudinal axis of the fiber corresponding to half the length of the fiber was measured, as well as the angle formed between the tangent to the central longitudinal axis of the fiber at a point halfway along the fiber and the straight line connecting one of the ends to the point on the central longitudinal axis of the fiber corresponding to half the length of the fiber. The results of these measurements demonstrate that the polyamide fibers are flexible and curved, not rigid and substantially rectilinear as presently claimed, whereas the polyimide-amide fibers are rigid and substantially rectilinear.

The enclosed § 1.132 Declaration filed on October 22, 2008 further demonstrates the fundamental difference between the claimed rigid, substantially rectilinear polymeric fibers and the conventional flexible, curled polymeric fibers of Colin and Piot.

More specifically, Tab A of the § 1.132 Declaration includes diagrams exemplifying the difference between incorporating conventional flexible, curled polymeric fibers in a traditional mascara composition and incorporating the claimed rigid, substantially rectilinear polymeric fibers in a mascara composition in accordance with an exemplary aspect of the present invention. As discussed in paragraph 2 and illustrated in these diagrams, flexible curled fibers and rigid substantially rectilinear fibers act differently on eyelashes. The flexible fibers curl owing to their flexible nature, meaning that the eyelashes also curl -- such eyelashes are unattractive, having a curled and non-lengthened appearance. In contrast, rigid, substantially rectilinear fibers do not curl, but rather remain rigid owing to their rigid nature -- when these rigid, substantially rectilinear fibers are applied to eyelashes, the result is an attractive, perceptibly lengthened eyelash.

As discussed in paragraph 3 of the § 1.132 Declaration, Tab B contains six pictures of eyelashes to which rigid, substantially rectilinear fibers have been applied, and demonstrates that

rigid, substantially rectilinear fibers provide eyelashes with an attractive, perceptibly lengthened effect, which results primarily from the fibers being in line with the eyelashes.

As discussed in paragraph 4 of the § 1.132 Declaration, Tab C contains four photographs -- the top two photographs are of a mascara composition containing polyimide-amide fibers (Kermel Tech, 3 mm) commercially available from Rhodia applied to false eyelashes, and demonstrates that the rigid Kermel fibers provide eyelashes with an attractive, perceptibly lengthened effect. As discussed in paragraph 5 of the § 1.132 Declaration, the bottom two photographs of Tab C depict a comparison between a composition containing 1% flexible polyamide fiber and a substantially identical composition containing 1% rigid, substantially rectilinear polyamide fiber. These photographs clearly demonstrate that the mascara composition containing flexible fibers results in eyelashes which are curled and unattractive, whereas the mascara composition containing rigid, substantially rectilinear fibers results in attractive, perceptibly lengthened eyelashes, which results primarily from the fibers being in line with the eyelashes (See e.g., paragraph 5).

Given that the fibers in both compositions were polyamide fibers, the difference in lengthening effects observed resulted from the rigidity/flexibility of the fibers, not chemical differences between the fibers -- thus, rigidity, not chemical nature, of the fibers is an important factor in achieving the observed lengthening effect (See e.g., paragraph 5).

These vastly different properties resulting from the two types of fibers were surprising and unexpected (See e.g., paragraph 6). Moreover, the fact that mascaras containing rigid, substantially rectilinear fibers of the present invention provide an attractive, perceptibly lengthened effect to mascaras is commercially significant -- eyelash lengthening is a very desirable property for a mascara product to have: the better the eyelash lengthening properties of a mascara, the more desirable the mascara will be to many consumers (See e.g., paragraph 8).

The evidence presented in the § 1.132 Declarations clearly demonstrate the fundamental difference between the claimed *rigid, substantially rectilinear* polymeric fibers and the

conventional *flexible, curled* polymeric fibers of Colin and Piot. This evidence also clearly demonstrates that Collin and Piot neither disclose nor reasonably suggest to a skilled artisan incorporating the claimed rigid, substantially rectilinear polymeric fibers into a mascara composition in accordance with the present invention.

As acknowledged in the Notice of Allowance mailed December 16, 2008, the polyamide fibers of Colin fail to anticipate or render obvious to a skilled artisan the mascara composition of the present invention comprising the claimed rigid, substantially rectilinear polymeric fibers. Since the polyamide fibers of Piot are identical to the polyamide fibers of Colin, Piot likewise necessarily fails to anticipate or render obvious to a skilled artisan the mascara composition of the present invention comprising the claimed rigid, substantially rectilinear polymeric fibers for the same reasons already of record.

Withdrawal of this ground of rejection is respectfully requested.

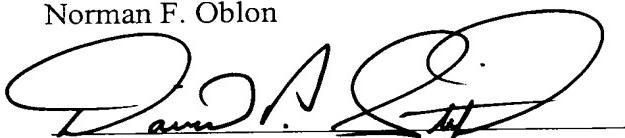
The rejection of claims 45-50 and 52-75 under 35 U.S.C. § 112, second paragraph, is obviated by amendment.

In conclusion, Applicants submit that the present application is now in condition for allowance and notification to this effect is earnestly solicited.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.

Norman F. Oblon



David P. Stitzel
Attorney of Record
Registration No. 44,360

Customer Number
22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 06/04)